05-24-04

EV329224215US

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Respectfully submitted,

By: Thomas L. Evans

Thomas L. Evans, PTO Reg. No. 35,805
BANNER AND WITCOFF, LTD.

Atty. Docket No.
005127.00197

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent of:

Allan M. SCHROCK ET AL.

U.S. Pat. App. No.: 10/086,644

Filed: February 28, 2002

For: PACE CALCULATION WATCH

Examiner: To Be Assigned

Group Art Unit: 2859

REQUEST FOR RECONSIDERATION

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

Applicants respectfully ask for reconsideration of both this application and the Office Action dated February 20, 2004.

In that Office Action, the Examiner rejected claims 9, 15, 30, and 44 under 35 U.S.C. §112, second paragraph. Applicants respectfully traverse this rejection, and ask for its reconsideration.

In making this rejection, the Examiner asserted that these claims (presumably, however, the Examiner is really only referring to claim 9) "do not include claim language that suggests

how the pace calculation system can be applied to a personal digital assistant." (See Office Action, page 2, lines 11-12.) Applicants respectfully point out that it is not the purpose of the claims to provide a blueprint for constructing embodiments of the invention. Instead, the claims are required only to set forth the metes and bounds of what the inventors believe to be their invention. With particular regard to claim 9, Applicants point out that one of ordinary skill in the art would readily understand the various structures and techniques by which embodiments of the invention could be incorporated into a personal digital assistant. It is therefore submitted that claim 9 fully complies with the provisions of 35 U.S.C. §112, second paragraph.

Similarly, the Examiner rejected to the language in these claims (presumably referring only to claims 15, 30, and 44) for defining the phrase "providing the calculated pace to another device." Applicants again point out that the function of the claims is not to provide a blueprint for constructing embodiments of the invention. Moreover, Applicants note that each of these claims is a method claim, not an apparatus claim. Accordingly, it would be appreciated by those of ordinary skill in the art that these claims would encompass any technique or mechanism for providing the calculated pace to another device, including (but not limited to) a hard-wired electronic transmission, transmission over infrared waves, and radio wave transmissions.[1] Accordingly, Applicants ask that the rejection of these claims under 35 U.S.C. §112, second paragraph, be withdrawn.

Next, the Examiner rejected claims 1-8, 10-14, 16-29, 31-43 and 45-51 under 35 U.S.C.

1. Applicants respectfully point out that the additional unsupported assertion that the subject matter of these claims is well known in the art is completely irrelevant to the rejection under 35 U.S.C. §112, second paragraph.

§103 over U.S. Patent No. 5,050,141 to Thinesen in view of U.S. Patent No. 5,526,290 to Kanzaki. The Examiner also rejected claims 9, 15, 30 and 44 over the combination of the Thinesen and Kanzaki patents, in further view of U.S. Patent No. 5,771,399 to Fishman. Applicants respectfully traverse both of these rejections, and courteously ask for their reconsideration.

Each of claims 1-51 recites the determination of a pace by dividing a distance stored in memory by an elapsed time or a segment of an elapsed time (i.e., a time that has already occurred). This feature is simply not taught or suggested by either Thinesen patent or the Kanazaki patent.

With regard to the Thinesen, this patent is expressly directed to establishing a pace by actuating command buttons in synchronism with the user's footsteps. (See, e.g., column 2, lines 11-14, column 8, lines 3-10, etc.). Thus, in addition to not teaching the features of the invention, the combination of the Thinesen patent with the Kanzaki patent suggested by the Examiner would vitiate the very teachings of the Thinesen patent.

The Kanzaki patent discloses determining a pace in a number of ways, but still does not teach or suggest determining a pace as recited in the claims. First, Kanzaki discloses calculating a target pace at which a user would need to run in order to travel a distance in a target time. (See, e.g., column 8, lines 55-58, column 17, lines 4-20, etc.) Thus, this type of "target" pace cannot be determined based upon an elapsed time. Kanzaki also discloses determining a pace by keying in pace data through a key switch. (See, e.g., column 6, lines 56-57.) Again, this portion of the Kanzaki patent does not teach or suggest determining a pace using an elapsed time. Still further,

the Kanzaki patent discloses determining a pace by receiving signals from a pedometer. (See column 12, line 61 to column 13, line 25.) Accordingly, the Kanzaki patent does not teach or suggest the features of the invention recited in any of claims 1-51.

Applicants therefore submit that no combination of the Thinesen and Kanzaki patents would teach or suggested the invention as recited in any of claims 1-51. Further, it is respectfully submitted that the Fishman patent does not remedy the omissions of the Thinesen and Kanzaki patents. Applicants accordingly ask that the rejection of claims 1-51 be withdrawn.

It is respectfully submitted that no fees are due for the consideration of this Request. If, however, the Examiner deems that fees are necessary, including any fees under 37 C.F.R. §1.116 or §1.17, then it is courteously requested that the Examiner charge such fees to the deposit account of the undersigned, Deposit Account No. 19-0733.

In view of the above remarks and comments, Applicants respectfully submit that all of the claims are allowable, and that this application is therefore in condition for allowance. Favorable action in this regard is courteously requested at the Examiner's earliest convenience.

Respectfully submitted,

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May 20, 2004